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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,591	12/11/2001	Masato Saito	016912-0202	1776

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EXAMINER	
WELLS, LAUREN Q	

ART UNIT	PAPER NUMBER
1617	

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/009,591	SAITO ET AL.	
	Examiner	Art Unit	
	Lauren Q Wells	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 December 2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-29* is/are pending in the application.

4a) Of the above claim(s) *8,11,14,17-20,23,26 and 29* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7,9,10,12,13,15,16,21,22,24,25,27 and 28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Clams 1-29 are pending. Claims 8, 11, 14, 17-20, 23, 26 and 29 are withdrawn from consideration, as they are directed to non-elected subject matter. The Amendment filed 12/16/03, amended claims 1-2, 6-8.

Applicant argues, "the withdrawal of claims 18 and 19 was in error. These claims should also be examined on the merits because they depend from examined claims 6 and 7, respectively". This argument is not persuasive. It is respectfully pointed out that claims 17 and 18 lack antecedent basis, as claims 6 and 7 do not recite polyoxyalkylene modified organopolysiloxanes. Additionally, polyoxyalkylene modified organopolysiloxanes was not elected as a species of the instant composition. See the response by Applicant to the Restriction/Election Requirement.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-4, 7, 10, 22, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Franklin et al. (EP 0 897 719) in view of Takamura et al. (5,035,832).

The instant invention is directed toward a composition comprising a polyoxyalkylene-modified organopolysiloxane having 2 or 3 alkylene carbon atoms, and at least one compound selected from polyhydric alcohols and polyoxyalkylene-glycol adducts having 2 or 3 alkylene carbon atoms; one or more compounds selected from silicic acid anhydride, silicic acid hydrate,

synthetic hydrotalcite, and synthetic calcined hydrotalcite; and a thickening agent; and which is substantially non-aqueous.

Franklin et al. teach a topical cleansing composition. Exemplified is a composition comprising 37% zeolite, 1% kaolin (thickening agent), 20.5% PEG-400 (polyhydric alcohol), and other ingredients. Silica or activated hydrotalcite is added to the composition as a heat generating material that can be combined with zeolite, wherein the heat generating material is taught as comprising 10-50% of the composition. The composition can have a viscosity of 150,000 cp as measured on a Brookfield viscometer. Shampoos are taught as preferred forms of the composition. The compositions are substantially non-aqueous. The reference lacks polyoxyalkylene-modified organopolysiloxane. See [0010]-[0025]; [0046]-[0049]; [0055].

Takamura et al. teach detergent compositions. Polyether-modified silicones are taught as ingredients that impart a soft finish, superior tensity to the hair, and superb light feeling to the skin when added to cosmetic compositions. See Col. 4, lines 29-59; Col. 5, lines 47-65.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the polyether-modified silicones taught by Takamura et al. to the shampoo compositions of Franklin et al. because of the expectation of achieving a shampoo that imparts a soft finish upon use, that imparts superior tensity to the hair, and that gives a superb light feeling to the skin.

Regarding the limitation, "that generate heat when contacted with water", it is respectfully pointed out that a compound and its properties are inseparable. Thus, since the references teach the same polyhydric alcohols, polyoxyalkylene glycols, and polyoxyalkylene modified organopolysiloxanes as that taught by the instant claims, the polyhydric alcohols,

polyoxyalkylene glycols, and polyoxyalkylene modified organopolysiloxanes, have the property of generating heat when contacted with water.

Claims 6, 9, 21 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Franklin et al. (EP 0 897 719) in view of Takamura et al. (5,035,832), and further in view of Maejima et al. (5,695,730).

The instant invention is directed toward a composition comprising a polyoxyalkylene-modified organopolysiloxane having 2 or 3 alkylene carbon atoms, and at least one compound selected from polyhydric alcohols and polyoxyalkylene-glycol adducts having 2 or 3 alkylene carbon atoms; one or more compounds selected from silicic acid anhydride, silicic acid hydrate, synthetic hydrotalcite, and synthetic calcined hydrotalcite; and a thickening agent; and which is substantially non-aqueous.

Franklin et al. teach a topical cleansing composition. Exemplified is a composition comprising 37% zeolite, 1% kaolin (thickening agent), 20.5% PEG-400 (polyhydric alcohol), and other ingredients. Silica or activated hydrotalcite is added to the composition as a heat generating material that can be combined with zeolite, wherein the heat generating material is taught as comprising 10-50% of the composition. The composition can have a viscosity of 150,000 cp s measured on a Brookfield viscometer. Shampoos are taught as preferred forms of the composition. The compositions are substantially non-aqueous. The reference lacks polyoxyalkylene-modified organopolysiloxane and silicic acid. See [0010]-[0025]; [0046]-[0049]; [0055].

Takamura et al. teach detergent compositions. Polyether-modified silicones are taught as ingredients that impart a soft finish, superior tensity to the hair, and superb light feeling to the skin when added to cosmetic compositions. See Col. 4, lines 29-59; Col. 5, lines 47-65.

Maejima et al. teach a process for preparing silicic acid hydrate. Silic acid hydrate is taught as a filler or a flatting agent for cosmetics. See abstract; Col. 7, lines 47-52.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the polyether-modified silicones taught by Takamura et al. to the shampoo compositions of Franklin et al. because of the expectation of achieving a shampoo that imparts a soft finish upon use, that imparts superior tensity to the hair, and that gives a superb light feeling to the skin.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add silicic acid hydrate, as taught by Maejima et al., to the composition of the combined references because the combined references teach the addition of silica to their compositions as an additional heat generating material and as stabilizing their composition, and silicic acid hydrate is a silica that Maejima et al. teaches as cosmetically acceptable; and because of the expectation of achieving a cosmetic product with body and uniformity, and which imparts a matte effect and softness to the user, which is the function of a cosmetic filler.

Regarding the limitation, "that generate heat when contacted with water", it is respectfully pointed out that a compound and its properties are inseparable. Thus, since the references teach the same polyhydric alcohols, polyoxyalkylene glycols, and polyoxyalkylene modified organopolysiloxanes as that taught by the instant claims, the polyhydric alcohols,

polyoxyalkylene glycols, and polyoxyalkylene modified organopolysiloxanes, have the property of generating heat when contacted with water.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Franklin et al. in view of Takamura et al. as applied to claims 1-4, 7, 10, 22, and 28 above, and further in view of Coury et al. (6,261,544).

Franklin et al. and Takamura et al. are applied as discussed above. The references lack sodium polyacrylate powder.

Coury et al. teach cosmetic compositions, wherein sodium polyacrylate powders are taught as fillers. Additives, such as fillers, are taught as comprising up to 10% of the composition. Fillers impart body or rigidity to compositions, and/or softness, a matte effect and uniformity to a composition. See Col. 14, lines 45-52.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the sodium polyacrylate powders taught by Coury et al. to the composition of the combined references because of the expectation of achieving a cosmetic product with body and uniformity and which imparts a matte effect and softness to the user.

Claims 13, 16 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Franklin et al. in view of Takamura et al. and further in view of Coury et al. as applied to claims 1-5, 7, 10, 22, and 28 above, and further in view of Macchio et al. (5,023,075).

Franklin et al., Takamura et al., and Coury et al. are applied as discussed above. The references fail to teach the size of the powder.

Macchio et al. teach polyacrylate powders as comprising 1-10% of a cosmetic composition and as having an average particle size of 10 microns as non-pore clogging and ultra-smooth upon application. See abstract; Col. 1, lines 14-57.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to teach the sodium polyacrylate powder of the combined references as having an average particle size of 10 microns because of the expectation of achieving a product wherein the powder does not clog pores and which is smooth upon application.

While the references do not explicitly teach the powder comprising 0.05-2%, it would have been obvious to one of ordinary skill in the art at the time the invention was made to teach the powder as comprising 0.05-2% of the composition because Coury et al. teach their additives as comprising less than 10% of the composition and it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Claims 12, 15, 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Franklin et al. in view of Takamura et al. in further view of Maejima et al. as applied to claims 6, 9, 21 and 27 above, and further in view of Coury et al. (6,261,544) and Macchio et al. (5,023,075).

Franklin et al., Takamura et al., and Maejima et al. are applied as discussed above. The reference lacks sodium polyacrylate powder.

Coury et al. teach cosmetic compositions, wherein sodium polyacrylate powders are taught as fillers. Additives, such as fillers, are taught as comprising up to 10% of the

composition. Fillers impart body or rigidity to compositions, and/or softness, a matte effect and uniformity to a composition. See Col. 14, lines 45-52.

Macchio et al. teach polyacrylate powders as comprising 1-10% of a cosmetic composition and as having an average particle size of 10 microns as non-pore clogging and ultra-smooth upon application. See abstract; Col. 1, lines 14-57.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the sodium polyacrylate powders taught by Coury et al. to the composition of the combined references because of the expectation of achieving a cosmetic product with body and uniformity and which imparts a matte effect and softness to the user.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to teach the sodium polyacrylate powder of the combined references as having an average particle size of 10 microns because of the expectation of achieving a product wherein the powder does not clog pores and which is smooth upon application.

While the references do not explicitly teach the powder comprising 0.05-2%, it would have been obvious to one of ordinary skill in the art at the time the invention was made to teach the powder as comprising 0.05-2% of the composition because Coury et al. teach their additives as comprising less than 10% of the composition and it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Response to Arguments

Applicant argues, "One of ordinary skill in the art would never have looked to Takamura to improve or modify the anhydrous composition disclosed by Franklin because the composition

of Takamura is an aqueous composition". This argument is not persuasive. It is respectfully pointed out that both Franklin and Takamura are directed to cosmetic compositions that are applied to the skin and the hair, and that Takamura teaches that incorporating polyether modified silicones (polyoxyalkylene modified organopolysiloxanes of the instant invention) into cosmetic compositions results in a product that imparts a soft finish, superior tensity to the hair, and superb light feeling to the skin. Just because the compositions of Franklin are anhydrous does not mean that one of ordinary skill would not look to aqueous prior art compositions that teach ingredients that impart benefits to cleansing composition, wherein Franklin is directed to cleansing compositions. It is respectfully pointed out that the Examiner has not combined the compositions of Takamura into those of Franklin.

Applicant argues, "There is no suggestion in Takamura whatsoever that 'extracting' from the aqueous composition one of the disclosed essential ingredients (the silicone derivative) and 'inserting' it into an anhydrous composition, such as one taught by Franklin, would impart the same desirable properties to the anhydrous composition as those arising only from the combination of the two essential ingredients". This argument is not persuasive. The Examiner respectfully directs Applicant to Col. 5, lines 48-65, which specifically teach the polyether modified silicone as a compound as imparting superior tensity to hair and a superb light feeling to the skin. Furthermore, it is respectfully pointed out that Franklin et al. teach alkyl polysaccharides as ingredients in their compositions. Thus, even if Col. 5, lines 48-65, is directed to the combination of alkyl polysaccharide and polyether modified silicone, adding the polyether modified silicone of Takamura into the invention of Franklin, still results in the combination of alkyl polysaccharide and polyether modified silicone.

Applicant argues, "the reference does not contain any direct and/or specific suggestion to employ specific polyoxyalkylene modified organopolysiloxanes according to the presently claimed invention. Each of the examples in Takamura employ silicone compounds that are not such organopolysiloxanes". This argument is not persuasive. First, it is respectfully pointed out that in a 103 rejection, the reference is considered as a whole as to what it teaches those of ordinary skill in the art, and is not limited to its disclosure of preferred embodiments. Second, it is respectfully pointed out that Col. 5, lines 48-65 specifically teach the polyether modified silicones as preferably silicone derivatives, and Col. 4, line 57, teaches KF351 as a preferred polyether modified silicone, wherein KF351 is a polyoxyalkylene modified organopolysiloxane having 2 or 3 alkylene carbon atoms.

Applicant argues, "The presence of the recited polyoxyalkylene modified organopolysiloxane in the claimed cosmetic gives rise to a number of beneficial properties that would not have been expected from the cited references". This argument is not persuasive, as Applicant has not provided any showings of unexpected results. The Examiner respectfully directs Applicant to the guidelines for showing unexpected results. It is applicant's burden to demonstrate unexpected results over the closest prior art. See MPEP 716.02, also 716.02 (a) - (g). Furthermore, the unexpected results should be demonstrated with evidence that the differences in results are in fact unexpected and unobvious and of both statistical and practical significance. *Ex parte Gelles*, 22 USPQ2d 1318, 1319 (Bd. Pat. App. & Inter. 1992). Moreover, evidence as to any unexpected benefits must be "clear and convincing" *In re Lohr*, 137 USPQ 548 (CCPA 1963), and be of a scope reasonably commensurate with the scope of the subject matter claimed, *In re Linder*, 173 USPQ 356 (CCPA 1972). While Applicant directs the

Examiner to pages 4 and 5 of the specification, it is respectfully pointed out that there is not a showing commensurate with MPEP 716.02 to establish unexpected results.

Regarding Maejima, Applicant argues, "But the reference makes only passing reference to the material's possible use in a cosmetic". This argument is not persuasive, as Maejima specifically teaches silic acid hydrate as a cosmetic ingredient that possesses beneficial properties.

Applicant argues, regarding Coury et al., "There is absolutely no suggestion whatsoever in the reference that sodium polyacrylate should be selected as a filler among many other recited fillers". This argument is not persuasive. Coury et al. does not recite a laundry list of powders. Further, the powders are taught as interchangeable for cosmetic use as fillers.

Applicant argues, regarding Macchio, "the reference explicitly teaches that the physical properties relied upon by the PTO result from the combination of polymethyl methacrylate, nylon, and polyethylene as 'critical ingredients'". This argument is not persuasive, as Macchio et al. is merely relied upon to teach the size of the powder.

Applicant a4rgues, "Macchio does not even teach sodium polyacrylate". This argument is not persuasive. It is respectfully pointed out that Macchio teaches polymethyl methacrylate powder, which is a polyacrylate powder.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is 571-272-0634. The examiner can normally be reached on M&R (5:30-4).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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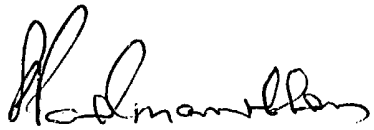

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